

REMARKS

Applicant thanks the Examiner for acknowledging the claim for foreign priority under 35 U.S.C. § 119, and noting that the priority documents have been received.

Election/Restrictions/Status of the Application

Applicant acknowledges that claims 5-8, 17, 22-26, 31, 33, 35-43, 45 and 46 are withdrawn from consideration.

By this Amendment, Applicant amends claims 1-4, 9-16, 18-21, 28-30, 32, 34 and 44, cancels claims 5-8, 17, 22-27, 31, 33, 35-43, 45 and 46, and adds new claims 47-52. Applicant respectfully submits that no new matter is added. Therefore, claims 1-4, 9-16, 18-21, 28-30, 32, 34, 44, 47-51 and 52 are all the claims pending in the application. Currently, claims 1-4, 9-16, 18-21, 28-30, 32, 34 and 44 stand rejected. Applicant hereby respectfully traverses all the rejections.

Information Disclosure Statement (IDS)

Applicant thanks the Examiner for initialing the IDS submissions filed on December 11, 2003 and April 6, 2005. However, with respect to the IDS submissions filed on April 30, 2004 and April 12, 2001, the Examiner asserts that the submissions do not comply with 37 C.F.R. § 1.98 (a)(3) (See Office Action: page 2-3). Applicant respectfully disagrees.

The IDS submission filed on April 30, 2004 concerns two references¹ cited in a counterpart Japanese Patent Office Action. With respect to references cited in a counterpart foreign office action, the MPEP states the following:

[w]here the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office (MPEP § 609.04(a) III.).

As such, at the time of the IDS filing on April 30, 2004, Applicant submitted a copy of a corresponding Japanese Patent Office Action dated February 3, 2004 along with an English translation of the pertinent portions thereof which cites the two references being submitted for consideration. Applicant respectfully submits that such submissions were in full compliance with the concise explanation requirement under 37 C.F.R. § 1.98 (a)(3). Therefore, Applicant respectfully requests that the Examiner consider the references cited in the IDS submission filed on April 30, 2004.

The IDS submission filed on April, 12 2001 concerns three Japanese patent references² cited in Applicant's Specification. Pertinent portion of the MPEP states the following:

[t]he concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities

¹ Japanese Unexamined Patent Application Publication No. H10-63844, published March 6, 1998 and International Publication No. WO99/50794, published October 7, 1999.

² Japanese Laid-Open Patent Application No. 11-96252, published April 9, 1999; Japanese Laid-Open Patent Application No. 63-13226, published March 24, 1988; Japanese Laid-Open Patent Application No. 4-33065, published February 4, 1992.

between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. (MPEP § 609.04(a) III.).

At the time of filing the IDS submission on April 12, 2001, Applicant stated that the references being submitted are discussed within the Specification beginning at page 2, line 9 and page 8, lines 4-5. As the relevance of three references are clearly stated in the pointed section of Applicant's Specification, Applicant respectfully submits that the concise explanation requirement under 37 C.F.R. § 1.98 (a)(3) is fully met. Therefore, Applicant respectfully requests that the Examiner consider the references cited in the IDS submission filed on April 12, 2001.

Claim Objections

Claims 1-4, 9-16, 18,-21, 28-30, 32, 34 and 44 are objected to for various informalities. Applicant thanks the Examiner for pointing out the informalities, and has amended claims 1-4, 9-16, 18,-21, 28-30, 32, 34 and 44 accordingly. Therefore, Applicant respectfully requests that the Examiner withdraw the objections.

Claim Rejections - 35 U.S.C. § 112

Claims 1-4, 9-16, 18,-21, 28-30, 32, 34 are rejected under 35 U.S.C. § 112, second paragraph (See Office Action: page 4). Applicant has amended claims 1-4, 9-12, 14-16, 19-21, 28-30, 32 and 34 to overcome the rejections. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections.

Claim Rejections - 35 U.S.C. § 102

Claims 1-4, 13-16, 18-20 and 21 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Danielson et al. (U.S Patent Publication No. 2003/0081860; “Danielson”).

Each of amended claims 1-3 and 4 recites, inter alia, “extracting first biometrics data submitted *by a person who is to receive the delivered article, at a time of ordering.*” Applicant respectfully submits that Danielson fails to disclose or suggest the noted feature of amended claims 1-3 and 4.

Danielson generally describes a portable hand-held data terminal which allows a capture of handwritten data (See Danielson: paragraph [0006]-[0007]). That is, the portable hand-held data terminal of Danielson provides “for the recording of signatures and for verification of the signatures recorded” (See Danielson: paragraph [0029]).

However, there is no description in Danielson that the stored signatures are captured *at the time of ordering of goods*. That is, Danielson lacks any description that the captured signatures bear any relation to a particular delivery order made at the time of ordering (See Danielson: paragraph [0069]-[0071]).

Further, Danielson fails to disclose or suggest “extracting first biometrics data submitted *by a person who is to receive the delivered article.*” Rather, in Danielson, it is unambiguously described that the captured and stored signatures may be that of “the authorized signatures of persons empowered to approve a given transaction” (See Danielson: paragraph [0070]). Applicant respectfully submits that the stored “authorized signatures” described in Danielson are

plainly distinguishable from the claimed “first biometrics data submitted *by a person who is to receive the delivered article.*”

In view of the foregoing, Applicant respectfully submits that amended claims 1-3 and 4 are patentable over Danielson.

Claims 13-15 and 16 likewise recite “extracting first biometrics data submitted by a person who made a delivery order for the article at a time of ordering.” Therefore, Applicant respectfully submits that claims 13-16 are patentable based on the rationale analogous to those discussed with respect to claims 1-3 and 4. Further, Applicant respectfully submits that amended claims 18-21 are patentable by virtue of their dependency from claims 14 and 16, respectively.

Claims 32, 34 and 44 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Van Till et al. (U.S Patent No. 6,404,337; “Van Till”).

Each of amended claims 32 and 44 recites, inter alia, “an extracting section which extracts first biometrics data of said person who made said order for said article” and “a verifying extraction section which extracts second biometrics data of a person who is to receive said article at a time of delivery.” Applicant respectfully submits that Van Till fails to disclose or suggest the noted features of amended claims 32 and 44.

Van Till generally provides a system and method to enable a customer to provide a digital signature at times when the customer is not present to physically sign for an ordered parcel (See Van Tills: col. 3, lines 54-64). As such, Van Till utilizes remote transmission of a pre-authorized digital signature to realize such system and method (See Van Tills: col. 4, lines 5-16). However, in Van Till, such digital signature is generated only *once*. Van Till merely

describes that the digital signature is first encrypted with a “hash function” and then verified (See Van Tills: col. 4, line 58 - col. 5, line 18). That is, in Van Till, there is no description of a generation of a second signature in addition to the digital signature described above. Therefore, Applicant respectfully submits that Van Till fails to disclose or suggest extracting “first biometrics data” *and* “second biometrics data,” as recited in amended claims 32 and 44.

In view of the foregoing, Applicant respectfully submits that amended claims 32 and 44 are patentable over Van Till. Further, Applicant respectfully submits that amended claim 34 is patentable by virtue of its dependency from claim 32.

Claim Rejections - 35 U.S.C. § 103

Claims 9-12, 28, 29 and 30 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Danielson in view of Uchida (U.S Patent No. 6,751,734; “Uchida”).

The secondary reference Uchida has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, Uchida constitutes prior art under 35 U.S.C. §. 102(e). However, rejections under 35 U.S.C. § 102(e) may be overcome by a showing under 37 CFR § 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another” (See MPEP § 706.02 (b)).

Therefore, Applicant hereby submits a 37 C.F.R. § 1.132 declaration, and respectfully requests to remove the 35 U.S.C. § 103 (a)/102 (e) rejections of claims 9-12, 28, 29 and 30.

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 09/832,826

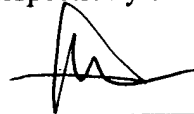
Attorney Docket No.: Q64083

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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